

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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CHERUBS – The Association of	:	
Congenital Diaphragmatic Hernia	:	
Research, Advocacy and Support,	:	
	:	
Petitioner,	:	
	:	
v.	:	
Breath of Hope, Inc.,	:	
	:	
Registrant.	:	
-----X	:	

**TTAB**

# 77436855

Cancellation No. 92050284

**Registrant Breath of  
Hope, Inc.'s Reply  
Memorandum In Support of  
Motion to Dismiss**

COMES NOW Registrant Breath of Hope, Inc. ("Breath of Hope"), through its attorneys, Zarin & Associates P.C., with this reply memorandum in support of its motion to dismiss, pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP §503.02, requesting dismissal of Petitioner CHERUBS – The Association of Congenital Diaphragmatic Hernia Research, Advocacy and Support's ("CHERUBS") Petition to Cancel Registrant Breath of Hope's supplemental trademark registration, Registration No. 3,503,325, for the mark "Congenital Diaphragmatic Hernia Awareness".



09-28-2009

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**I. Argument**

**A. Petitioner Lacks Standing To Bring Its Petition to Cancel**

In its motion to dismiss, Breath of Hope argues that, assuming the veracity of the allegations in Petitioner's petition, Petitioner has no "real interest" in the outcome of its cancellation petition, because Breath of Hope's registration is on the Supplement Register rather than the Principal Register. As a Supplemental Registrant, Breath of Hope has no more or less substantive rights than Petitioner to use the trademark 'Congenital Diaphragmatic Hernia Awareness'.

Petitioner contends that, if the Board embraces Breath of Hope's argument, then "there could be no grounds for cancellation of any mark registered on the Supplemental Register other than abandonment or dilution," and that "[s]uch a result was clearly not contemplated by the Lanham Act." (Petitioner's Brief, p. 9) Under the language of the statutory provisions at issue, however, Petitioner is wrong.

The current version of 15 U.S.C. §1092 provides, in relevant part:

Whenever any person believes that such a person is or will be damaged by the registration of a mark on the supplemental register –

(1) for which the effective filing date is after the date on which such person's mark became famous and which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c)[15 U.S.C. §1125(c)]; or

(2) *on grounds other than dilution by blurring or dilution by tarnishment*, such person may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefore, apply to the Director to cancel such registration.

15 U.S.C. §1092(2) (emphasis supplied). This statutory provision is crystal clear that cancellation is possible if *either* dilution is likely, pursuant to subsection (1), *or* for

reasons “other than dilution,” pursuant to subsection (2). Moreover, 15 U.S.C.

§1091(a) provides the reasons for cancellation “other than dilution”, stating that

All marks capable of distinguishing applicant’s goods or services and not registrable on the principal register herein provided, *except those declared to be unregistrable under subsections (a), (b), (c), and (e)(3) of section 2 of this Act [15 U.S.C. §1052]*, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of subsections (a) and (e) of section 1 [15 U.S.C. §1051] so far as they are applicable.

15 U.S.C. §1091(a) (emphasis supplied). This statutory provision unambiguously indicates that registrations on the Supplemental Register may be cancelled for any of the reasons delineated in subsections (a), (b), (c) or (e)(3) of 15 U.S.C. §1052; none of these subsections permits cancellation due to dilution. It also indicates that such registrations may be cancelled if the trademarks for which they were issued are not “capable of distinguishing applicant’s goods or services.” See 15 U.S.C. §1091(a).

“Under Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a), a term is protectable as a trademark only if the public recognizes it as identifying the claimant’s goods or services and distinguishing them from those of others.” *Berner International Corp. v. Mars Sales Company*, 987 F.2d 975, 979 (2d Cir. 1993). And importantly,

If a term is arbitrary or suggestive, courts will treat it as distinctive and automatically qualify it for trademark protection. If a term is descriptive, trademark protection will exist only if a claimant proves that the term conveys to consumers a secondary meaning of association with the claimant. Finally, if a term is generic, courts are unwilling to afford it trademark protection.

*Id.* Significantly, “[a] generic term cannot be registered on either the Principal or Supplemental Registers,” but “[a] mark may be registered on the Supplemental Register if it is inherently non-distinctive (such as a descriptive phrase), and is capable

of achieving trademark status through the acquisition of secondary meaning and distinctiveness.” *Boston Duck Tours v. Super Duck Tours, LLC*, 531 F.3d 1, 8 n. 5 (1<sup>st</sup> Cir. 2008); see also *Innovation Ventures, LLC v. N2G Distributing, Inc.*, 2008 U.S. Dist. LEXIS 30047 at \*9 (April 14, 2008 E.D. Mich.) (“But a mark that will not, prima facie, be protected, may, through use, become distinctive of applicant’s goods and thus receive protection.”)

Consequently, in addition to the grounds for cancellation of a Supplemental Registration delineated in subsections (a), (b), (c) or (e)(3) of 15 U.S.C. §1052, cancellation of a Supplemental Registration is possible if a petitioner can demonstrate that the registration was issued for a trademark which is not descriptive (i.e. generic) *because* it has not acquired secondary meaning, thereby rendering the trademark not “capable of distinguishing applicant’s goods or services.” 15 U.S.C. §1091(a). Clearly, therefore, Petitioner is wrong that, if the Board adopts Breath of Hope’s argument, there “could be no grounds for cancellation of any mark registered on the Supplemental Register other than abandonment or dilution.” (Petitioner’s Brief, p. 9)

Petitioner further contends that support for its rejection of Breath of Hope’s argument is somehow found in *Novartis Consumer Health, Inc. v. McNeil-PPC, Inc.*, 1999 U.S. Dist. LEXIS 20981 (September 13, 1999 D.N.J.), a case cited by Breath of Hope, because that case states that “a suit for the infringement of a mark registered on the Supplemental Register may be brought in federal court.” *Id.* at \*13; (Petitioner’s Brief, p. 9) Indeed, this is a correct statement.

A common law owner of a trademark who has *no* Supplemental Registration, however, *also* has the right to bring claims for trademark infringement in federal court pursuant to 15 U.S.C. §§1114 and 1125. Indeed, such claims arise under federal law, and therefore federal courts have subject matter jurisdiction over them pursuant to 28 U.S.C. §1331. Cancellation of Breath of Hope's Supplemental Registration, therefore, would not alter in any way Breath of Hope's right to bring claims against Petitioner in federal court for any infringement of its trademark rights.

In its motion to dismiss, Breath of Hope contends that Petitioner has no "real interest" in the outcome of its petition to cancel, because Petitioner would not suffer any injury if the registration remains in effect. (Breath of Hope's Brief, p. 15) As long as Breath of Hope's Supplemental Registration remains in effect, both Breath of Hope and Petitioner have an equal right to use the term 'Congenital Diaphragmatic Hernia Awareness'.

As Breath of Hope has explained, such is the case because, unlike a Principal Registration, a Supplemental Registration does *not* create a 'presumption' that the registrant's mark constitutes a protectable trademark or that the registrant has the exclusive right to use the term which is the subject of the registration. Also as Breath of Hope has explained, if Petitioner is permitted to prosecute its cancellation petition and prevails on that petition, its success will create a 'presumption' that the term 'Congenital Diaphragmatic Hernia Awareness' is generic and therefore that Breath of Hope has no trademark rights in the term. This 'presumption' against Breath of Hope places Breath of Hope at a disadvantage relative to Petitioner in any

subsequent federal action for trademark infringement. Petitioner admits this to be the case and argues that it is entitled to this advantage over Breath of Hope, stating that “a ruling that [Breath of Hope’s] Purported Mark is generic and not protectable is precisely what Petitioner seeks.” (Petitioner’s Brief, p. 10)

In arguing in favor of its right to seek this presumption, however, Petitioner ignores the objective of the standing requirement for bringing a petition to cancel. “[T]o have standing an opposer [or petitioner] to a registration is required to have a legitimate personal interest in the opposition [or cancellation].” *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999). When no presumption exists in favor of either party, as is the case when the registrant has a registration on the Supplemental Register, the *creation* of a presumption in favor of the petitioner simply is not a “legitimate personal interest” in cancellation. On the contrary, when a presumption exists in favor of a registrant, as is the case when the registrant has a registration on the Principal Register, the *elimination* of that presumption in favor of that registrant indeed does constitute a “legitimate personal interest” in cancellation. In other words, a petitioner has a legitimate interest in arriving at the doorstep of a federal court *without* a pre-existing *disadvantage*, but it has no legitimate interest in arriving at that doorstep *with* a pre-existing *advantage*.

As Petitioner readily admits, it seeks to reach a federal court with the distinct advantage over Breath of Hope that the term which is the subject of Breath of Hope’s Supplement Registration, ‘Congenital Diaphragmatic Hernia Awareness’, is ‘presumptively’ generic and therefore not protectable. Petitioner therefore has no

“legitimate personal interest” in the outcome of its cancellation petition.

Consequently, it has no “real interest” in the proceeding and lacks standing to bring it.

To support its position that it has a “real interest” in the outcome of its petition to cancel Breath of Hope’s Supplemental Registration for the mark ‘Congenital Diaphragmatic Hernia Awareness’, and therefore standing to bring this petition, Petitioner cites *Clairol, Inc. v. Roux Distributing Co., Inc.*, 280 F.2d 863 (C.C.P.A. 1960). First and most importantly, the issue in that case was *not* whether the petitioner had ‘standing’ to bring its petition to cancel, but rather the court assumed standing and addressed the question whether the trademark at issue was protectable. And second, the court issued that decision in 1960, almost forty (40) years before the *Ritchie v. Simpson* court articulated the “real interest” standard for determining whether a petitioner has standing to bring a petition to cancel.

**B. Petitioner Cannot Bring A Claim For Cancellation Due To Fraud**

Breath of Hope also contends that, even if Petitioner has standing to bring its petition, its claim for fraud must be dismissed, because, unlike a registration on the Principal Register, a registration on the Supplemental Register cannot, as a matter of law, be cancelled due to fraud by the registrant. (Breath of Hope’s Brief, pp. 17-18) Petitioner challenges this argument by citing 15 U.S.C. §1092, which it claims to “permit[ ] parties to bring cancellation proceedings against marks on the Supplemental Register on the basis of fraud.” (Petitioner’s Brief, p. 12)

As Breath of Hope has explained in response to Petitioner’s argument that the Board should reject Breath of Hope’s contention that Petitioner lacks standing to



bring its petition because, if it does not, there could be no grounds, other than abandonment or dilution, for cancellation of any mark registered on the Supplemental Register, 15 U.S.C. §1092(2) does not permit a party to bring a petition for cancellation on simply any grounds it wishes, but only allows it to bring such a petition on the grounds delineated by 15 U.S.C. §1092(1) or 15 U.S.C. §1091(a). And as previously explained, section 1091(a) does not cite 15 U.S.C. §1064(3), the statutory provision which permits cancellation of a Principal Registration for fraud, as a ground for cancellation of a registration on the Supplemental Register. (Breath of Hope's Brief, pp. 17-18)

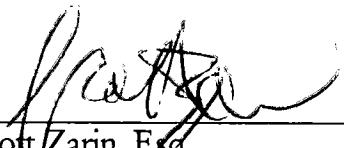
As an illustration of this point, Breath of Hope has pointed to the decision of the court in *Novartis Consumer Health, Inc. v. McNeil-PPC, Inc.*, which explicitly "acknowledges that 15 U.S.C. §1064 [which includes fraud as a ground for cancellation of a Principal Registration] does not apply to cancellations of Supplemental Registrations," and dismisses the defendant's counterclaim for cancellation of a Supplemental Registration due to fraud. *Novartis*, 1999 U.S. Dist. LEXIS 20981 at \*28. Oddly, despite this clear and unequivocal holding, Petitioner claims that "[n]owhere in [the *Novartis*] decision did the court hold that marks on the Supplemental Register could not be cancelled on the ground of fraud." (Petitioner's Brief, p. 12) Clearly, Petitioner has misread *Novartis*.

## II. Conclusion

For all the foregoing reasons, in addition to those articulated in Breath of Hope's motion to dismiss, the Board should: (1) DISMISS Petitioner's petition to cancel Breath of Hope's Supplemental Registration for lack of standing; or, in the alternative; (2) DISMISS Petitioner's claims for fraud and genericness for failure to state a claim for relief.

Respectfully submitted,

Dated: September 24, 2009



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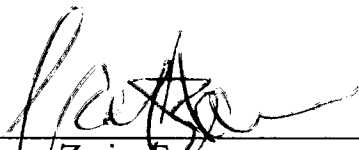
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Scott Zarin, Esq.

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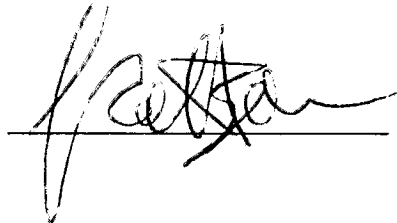
I, Scott Zarin, Esq., declare, under penalty of perjury, that, on September 24, 2009, I served, via E-mail and U.S. First Class Mail

**Registrant Breath of Hope, Inc.'s Reply Memorandum In Support of Motion to Dismiss**

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A handwritten signature in black ink, appearing to read 'A. DeBaugh', is written over a horizontal line.